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Technology Center 2100

Paper No. 15

In re Application of Moriwake et al. :
Application No. 09/068,866 : DECISION DISMISSING PETITION
Filed: October 23, 1998 : INVOKING SUPERVISORY AUTHORITY
Attorney Docket No. 450108-4484 : OF THE COMMISSIONER UNDER
Title: EDITING SYSTEM, EDITING METHOD, : 37 CFR §1.181
CLIP MANAGEMENT APPARATUS, AND :
CLIP MANAGEMENT METHOD :
:

This is a decision on the petition filed on March 29, 2002 to withdraw the finality of the Office action (Paper No. 11) mailed on December 10, 2001. The petition is being considered as a petition invoking the supervisory authority of the Commissioner under 37 CFR §1.181.

The petition is **DISMISSED**.

Applicable Prosecution History

March 27, 2001 Restriction requirement mailed to applicants.

April 30, 2001 Applicants responded to restriction requirement by electing Claims 1-89, 91, 94-121 and 133 without traverse. The elected group is drawn to an editing system.

July 16, 2001 First action on the merits mailed. Claims 1-89, 91, 94-121 and 133 are rejected under 35 USC 112, second paragraph. In paragraph 8, the examiner requests the applicants review all claims for phraseology that can lead to misinterpretation or misunderstanding in addition to the problems delineated. The claims were also rejected under 35 USC 103(a) as being unpatentable over McGrath in view of Nagasaka in view of Lavelle.

November 16, 2001 Applicants file a response canceling Claims 1-142 and adding new claims 143-161 drawn to an editing system. Applicants also filed a verified English translation of the priority application no. 08-249381 with a filing date of September 20, 1996 which antedates the applied prior art of McGrath.

December 10, 2001

Final rejection mailed rejecting Claims 143-161 as being unpatentable over Klinger and Langford. The examiner stated the applicants' amendment necessitated the new grounds of rejection.

Issues

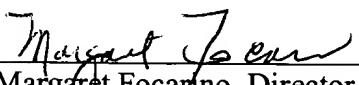
Petitioners argue they cancelled claims 1-89, 91, 94-121 and 133 and incorporated the limitations from those cancelled claims into new claims 143-161. They maintain the new claims were presented in a form consistent with U.S. practice and that an editing system and method for producing a resultant clip from a plurality of clips remained under examination. Petitioners further state "the subject matter under examination after the November 2001 Amendment was not *substantially different* than the subject matter under examination before the November 2001 Amendment." [Italics added.] Petitioners also argue the filing of the verified English translation to antedate the McGrath reference was not justification for a final rejection. Therefore the amendment filed November 16, 2001 did not necessitate the new grounds of rejection made in the final rejection mailed December 10, 2001.

Decision

A review of the Office actions and applicants' responses indicates the applicants did change the scope of the invention by the amendment filed November 16, 2001. The appropriate standard to make the subsequent Office action a final rejection is not whether the subject matter under examination was "substantially different" as petitioner argues, but whether the amendment necessitated new grounds of rejection. Originally filed independent Claim 1 contained means plus function language for the editing means and newly added Claim 143 addressed the editing system with the omission of that editing means and a redefining of the scope regarding the "plurality of modules." A comparison of the editing method claimed in original Claim 94 and new added independent Claim 153 shows the scope changed regarding the applying and managing steps of Claim 94 to steps of "selectively performing", "managing information" and "controlling" (Claim 153).

While applicants' submission of a verified English translation of the priority document may have been a factor in the examiner changing the applied art under 35 USC 103(a), the record supports the examiner's statement that applicants' amendment of the claims necessitated a new grounds of rejection based upon applicants' changing the scope of the claimed invention. The examiner's second action mailed December 10, 2001 was a proper final rejection and was consistent with USPTO policy and practice. Accordingly, the petition is **DISMISSED**.

Any request for reconsideration of this decision must be filed within two months of the mailing date of this decision. However, this period does not extend petitioners' period for reply set forth in the final rejection.



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